

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

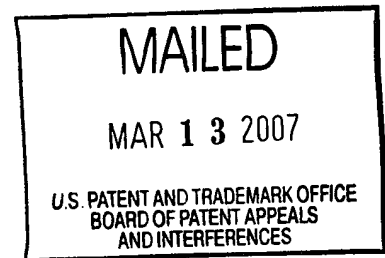
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL J. CURRY, RUDY D. MARTIN, DOUGLAS Z. PAN,
and RICHARD T. SIMONI JR.

Appeal 2006-2828
Application 09/683,995
Technology Center 2100

Decided: March 13, 2007



Before KENNETH W. HAIRSTON, ALLEN R. MACDONALD, and,
JEAN R. HOMERE *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-24.

THE INVENTION

The disclosed invention relates generally to messaging programs, such as email messaging programs, and more particularly to such programs that have built-in video and/or audio media recording and/or playback capabilities (Specification 1).

Representative claim 1 is illustrative:

1. A system comprising:

a network;

a first client having a first email messaging program installed thereon on which a composing user composes a message and records media, the first email messaging program sending the message to a receiving user over the network; and,

a second client having a second email messaging program installed thereon on which the receiving user receives the message over the network, the second email messaging program playing back the media upon the user viewing the message.

THE REFERENCE

The Examiner relies upon the following reference as evidence of anticipation:

Budge

US 6,564,248 B1

May 13, 2003

THE REJECTION

The following rejection is on appeal before us:

1. Claims 1-24 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over the teachings of Budge.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for the respective details thereof.

OPINION

Only those arguments actually made by Appellants have been considered in this decision. It is our view, after consideration of the record before us, that the evidence relied upon supports the Examiner's rejection of the claims on appeal. Accordingly, we affirm.

Claims 1-24

We consider the Examiner's rejection of claims 1-24 as being anticipated by Budge. Since Appellants' arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will consider independent claim 1 as the representative claim for this rejection. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also* (Br., 3). "For purposes of this appeal only, Applicant groups all pending claims 1-24 within a single group, and selects claim 1, as representative of these claims."

Appellants argue that Budge does not disclose a first email messaging program on which a composing user composes a message *and* records media and which sends the message over the network (Br. 4).

Appellants further argue that Budge does not disclose a second email messaging program receiving the message over the network *and* playing back the media upon the user viewing the message (*id.*).

Appellants clarify their interpretation of the claim language by stating:

Whereas, the invention of claim 1 is limited to a *single* program, an e-mail messaging program, *both recording media and sending a message* (including the media) over

the network, in Budge these functionalities are divided into two separate programs: the video-email recorder 210 and the e-mail client 270. Furthermore, where the invention of claim 1 is limited to a *single* program, an e-mail messaging program, *both receiving the message over the network and playing back the media*, in Budge these functionalities are divided into two separate programs: the e-mail client 270 and the video-email player 220. (Br. 5, emphasis in original).

The Examiner disagrees. The Examiner maintains that claim 1 reads on the Budge reference. In particular, the Examiner reads the claimed first and second clients on “sending sub-system 2,” and “receiving sub-system 4,” respectively (Fig. 1, col. 3, ll. 16-42). The Examiner reads the claimed “first email messaging program” on “VIDEO E-MAIL SOFTWARE 50” (Fig. 1, col. 3, ll. 38-42). The Examiner reads the claimed “second email messaging program” on “VIDEO E-MAIL PLAYER 220” (Fig. 2B, col. 4, ll. 31-36 and 44-49). The Examiner reads the claimed “network” on “communication link 8” (Fig. 1, col. 3, l. 19). The Examiner thus concludes that Budge anticipates the claimed invention (Answer 12-13).

“During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification.” *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1358, 49 USPQ2d 1464, 1467 (Fed. Cir. 1999).

When we construe instant claim 1 in accordance with the broadest reasonable interpretation consistent with the Specification, we conclude that

the language of the claim is not limited to a single e-mail messaging program that *records media and* sends a message (including the media) over the network, nor is the language of the claim limited to an e-mail messaging program that *receives the message over the network and* plays back the media, as argued by Appellants (*see* Br. 5).

In contrast, we find the language of the claim merely requires a first client *on which* a composing user composes a message and records media, the first email messaging program sending the message to a receiving user over the network, and, a second client *on which* the receiving user receives the message over the network, the second email messaging program playing back the media upon the user viewing the message, where the first and second clients have first and second email messaging programs installed thereon, respectively.

We note that this broad but reasonable interpretation is fully consistent with the Specification that discloses, in one embodiment, an e-mail messaging program that is not integrated with a media player:

Playback can be performed in a number of different manners, and *is not limited to integration with the email messaging program . . .* As another example, the user may be using an installed email messaging program, but the code that actually plays back the media *may not be part of the program itself. The playback may be accomplished by a subsidiary program.* (Specification, 8, ¶ 0033, emphasis added).

We conclude that Appellants are arguing limitations from the Specification. We note that patentability is based upon the claims. “It is the claims that measure the invention.” *SRI Int’l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (*en*

banc). A basic canon of claim construction is that one may not read a limitation into a claim from the written description. *Renishaw plc v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1248, 48 USPQ2d 1117, 1120 (Fed. Cir. 1998).

In the instant case, we find that Appellants' narrow interpretation of the claimed "email messaging program" (i.e., as requiring integrated e-mail composing and media recording/playback features) is inconsistent with Appellants' own Specification that broadly *defines* the claimed "email messaging program" in the following manner: "An email messaging program is *defined* herein as *a program that can both send and receive email*" (Specification, 1, ¶ 0003, emphasis added). Thus, for at least the aforementioned reasons, we find the language of claim 1 broadly but reasonably reads on the Budge reference in the manner argued by the Examiner. Because we find that Budge discloses all that is claimed, we will sustain the Examiner's rejection of representative claim 1 as being unpatentable over Budge.

Pursuant to 37 C.F.R. § 41.37(c)(1)(vii), we have decided the appeal with respect to claims 2-24 on the basis of the selected claim alone. Therefore, we will sustain the Examiner's rejection of these claims as being anticipated by Budge for the same reasons discussed *supra* with respect to representative claim 1.

DECISION

In summary, we have sustained the Examiner's rejection of all claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-24 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED.

PGC/GW

LAW OFFICES OF MICHAEL DRYJA
704 228TH AVENUE NE
PMB 694
SAMMAMISH, WA 98074